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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,849	12/27/2000	Hideki Toshikage	7254/63304	4792
7590	12/30/2003		EXAMINER	
			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/749,849	TOSHIKAGE ET AL.	
	Examiner	Art Unit	
	Mary Cheung	3621	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 20 October 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on October 20, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/749,849 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Status of the Claims***

2. Claims 1-11 are pending. Claims 1 and 6 have been amended. Claims 12-70 have been canceled.

### ***Claim Objections***

3. Claims 1, 5-6 and 11 are objected to because of the following informalities:
- In lines 15-16 of claim 1, the phrase "said internet" should be "said Internet";
  - In line 2 of claim 5, the phrase "claim 1" should be "claim 4";
  - In lines 13-14 of claim 6, the phrase "said internet" should be "said Internet";
  - In line 2 of claim 11, the phrase "claim 6" should be "claim 10".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Garfinkle et al., U. S. Patent 6,017,157.

As to claim 1, Ginter teaches an image commercial transactions system comprising (Fig. 1):

- a) A reception host including (Figs. 1-1A, 7):
- b) An image printing machine having an image scanner for converting a document into digital image data (column 299 lines 36-42),
- c) A server for storing said digital image data (column 299 lines 36-42 and Figs. 1-1A, 7),
- d) A computer for accepting a sale of a digital image stored on said server in a digital data format with a handling condition related to said digital image (column 53 lines 39-60 and column 54 lines 26-56 and Figs. 1, 15A; specifically, "*a handling condition corresponding to the "rules and controls" in Ginter's teaching*"),
- e) Transferring means for transferring said digital image with said handling condition in said digital data format stored in said server to a receiver side via an

Internet line so that digital image data transferred via said internet line is developed into a condition modified based on said handling condition (column 53 lines 39-60 and column 54 lines 26-56 and column 307 lines 6-9 and Figs. 1, 15A);

f) A charge accounting dealer for effecting an electronic charging accounting transaction for the transfer by said reception host of data of said digital image with said handling condition to said receiver side (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

Ginter does not specifically teach the digital image is developed into a printed picture modified based on said handling condition via the Internet line. However, Ginter teaches the digital image is developed into a condition that modified based on said handling condition as discussed above, Ginter also teaches the digital image including pictures (column 59 lines 28-30). It would have been obvious one of ordinary skill in the art to allow said condition in Ginter's teaching to be a printed picture because this would allow the picture related data to be better distributed according to the handling condition.

Ginter teaches the digital image data is transmitted in the system including pictures (column 59 lines 28-30 and column 283 lines 5-12). Ginter does not explicitly teach that the image printer machine and the image scanner as discussed above are a photographic image printing machine and a photographic image scanner, respectively. Garfinkle teaches a photographic image printing machine having a photographic image scanner for converting a picture on a film into photographic digital image data (column 2

lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the image printer and the image scanner of Ginter to be a photographic image printer and a photographic scanner because it would allow the picture related data to be better captured and later to be better distributed.

As to claims 2 and 7, Ginter teaches said reception host transfers said data of said digital image subjected to one of a scrambling processing and a masking process (column 59 lines 48-54 and column 150 lines 35-43).

As to claims 3 and 8, Ginter teaches said reception host subjects said data of said digital image to a scrambling process/enciphering, and transfers key data of said scrambling process/enciphering (column 59 lines 48-67).

As to claims 4 and 10, Ginter teaches said reception host transfers said digital image with said handling condition and an advertisement in said digital format (column 317 lines 22-42 and column 320 lines 2-20).

As to claims 5 and 11, Ginter teaches said reception host transfers data of said advertisement synthesized with said data of said image and with said handling condition (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 6, Ginter teaches an image commercial transactions method comprising (Fig. 1):

- a) A reception host step including (Figs. 1-1A, 7);
- b) An image scanning step for converting a document into digital image data (column 299 lines 36-42),

- c) A processing step of enabling a reception host to accept a transfer of a digital image stored on a server in a digital data format with a handling condition related to said digital image (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1-1A, 7, 15A; specifically, "*a handling condition corresponding to the "rules and controls" in Ginter's teaching*"),
- d) A transfer step of enabling said reception host to transfer said digital image with said handling condition in said digital data format to a receiver side via an Internet line so that digital image data transferred via said internet line is developed into a condition modified based on said handling condition (column 53 lines 39-60 and column 54 lines 26-56 and column 307 lines 6-9 and Figs. 1, 15A);
- e) A charge accounting step of enabling a charge accounting dealer to effect an electronic charging accounting transaction for the transfer by said reception host of data of said digital image with said handling condition to said receiver side (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

Ginter does not specifically teach the digital image is developed into a printed picture modified based on said handling condition via the Internet line. However, Ginter teaches the digital image is developed into a condition that modified based on said handling condition as discussed above, Ginter also teaches the digital image including pictures (column 59 lines 28-30). It would have been obvious one of ordinary skill in the art to allow said condition in Ginter's teaching to be a printed picture because this would

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allow the picture related data to be better distributed according to the handling condition.

Ginter teaches the digital image data being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanning step for converting a document into digital image data. Ginter does not explicitly teach converting a picture on a film into photographic digital image data. Garfinkle teaches an image scanning step including converting a picture on a film into photographic digital image data (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow the image scanning step for converting in Ginter's teaching to include the feature of converting a picture on a film into photographic digital data because it would allow the picture related data to be better captured and later to be better distributed.

As to claim 9, Ginter teaches said transfer step enables said reception host generate predetermined additional information for said data of said digital image, and transfers said generated additional information in said digital format along with said data of said image with said handling condition (column 317 lines 22-42 and column 320 lines 2-20).

#### ***Response to Arguments***

7. Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Ginter in view of Garfinkle fails to teach the newly added limitation of transferring a digital image with a handling condition in a digital data format stored in a server to a receiver said via an Internet line so that the digital image data transferred via the Internet line is developed into a printed picture and modified based on the handling condition, examiner has revised the rejections accordingly. Please see the rejections in claims 1 and 6 above.

*Inquire*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306      (Official Communications; including After Final Communications labeled "BOX AF")

(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung      *Mary Cheung*  
Patent Examiner  
Art Unit 3621  
December 22, 2003